

## REMARKS

### **I. Amendments**

By this amendment, claims 12, 14 and 17 have been amended; and claim 13 has been canceled. Claim 14 has been amended to recite a reagent in accordance with the specification at page 99, reagent VIa.

Typographical errors have also been corrected in the specification at page 28.

This amendment adds no new matter to the specification. Support for this amendment is found in the specification and claims as filed.

### **II. Acknowledgement of Allowable Claims**

Applicants acknowledge the Examiner's indication of the allowability of claims 1-5, 7-11, 14, 15, 22, 43 and 44.

### **III. Discussion of the Rejection of Claims 13 and 17 under 35 U.S.C. Sec. 112, First Paragraph**

Claims 13 and 17 have been rejected under 35 U.S.C. Sec. 112, first paragraph, as allegedly non-enabled with respect to the term "pro-drug".

By this amendment, claim 13 has been cancelled and claim 17 has been amended to omit reference to prodrugs.

Therefore, Applicants respectfully request withdrawal of the Sec. 112, first paragraph rejection.

### **IV. Discussion of the Objection to the Specification**

Applicants wish to thank the Examiner for pointing out two additional typographical errors. By this amendment, those errors have been corrected in the specification at page 28.

**V. Discussion of the Rejection of Claim 12, Third Compound Under 35 U.S.C. Sec. 112, Second Paragraph**

Claim 12 has been rejected under 35 U.S.C. Sec. 112, second paragraph as allegedly vague with respect to punctuation for the third compound recited.

By this amendment, Applicants have amended claim 12 to change the close bracket symbol to a close parentheses symbol for the third compound recited.

Therefore Applicants respectfully request withdrawal of the Sec. 112, second paragraph rejection.

**VI. Discussion of the Rejection of Claim 12, Twelfth Compound Under 35 U.S.C. Sec. 112, First Paragraph**

Claim 12 has been rejected under 35 U.S.C. Sec. 112, first paragraph as allegedly not enabled with respect to the twelfth compound recited.

The Examiner does not believe that the species representing R<sup>1</sup> in the twelfth compound recited is supported by the genus for R<sup>1</sup> recited in the specification.

The Examiner is respectfully reminded that claim 12 is an independent claim.

The twelfth compound of claim 12 is supported both *specifically* in the specification as Example 90 appearing on page 216 of the specification; and also *generally* by the description of R<sup>1</sup> in the specification. To illustrate how this compound falls under the R<sup>1</sup> designations, attached Appendix A is provided for the Examiner's consideration. In the attached Appendix, the structure of the compound is shown broken down into the parts corresponding to R<sup>1</sup> descriptions in the specification.

R<sup>1</sup> is defined as an aralkyl group such as a benzyl group on page 23, line 29-30 of the specification; and as an alkyl group such as a methyl group on page 23, line 9 of the specification. Given that page 23, lines 2-8 indicates that the hydrocarbon group may be a combination of these groups, the -CH<sub>2</sub>-C<sub>6</sub>H<sub>4</sub>-CH<sub>2</sub>- unit is obtained.

The hydrocarbon group (herein a combination of benzyl + methyl) can be substituted, according to the specification as indicated on page 24, line 28 – page 28, line 15. Di-lower

alkylamino groups including diethylamino are recited as appropriate substituents in option (xi) on page 25, lines 8-10.

Therefore, as the twelfth compound is enabled both specifically and generally by the specification, Applicants respectfully request withdrawal of the Sec. 112, first paragraph rejection.

**VII. Discussion of the Rejection of Claim 12, Twelfth Compound under 35 U.S.C. Sec. 101**

Claim 12 has been rejected under 35 U.S.C. Sec. 101 as allegedly unsupported with respect to the twelfth compound recited.

Applicants hereby incorporate their argument made above in Sec. VI, which is equally applicable to overcome the Sec. 101 rejection.

Applicants respectfully request withdrawal of the 35 U.S.C. Sec. 101 rejection.

**VIII. Conclusion**

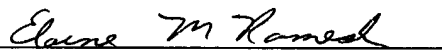
Reconsideration of the claims as amended and allowance is requested. Should the Examiner believe that a conference with Applicants' attorney would advance prosecution of this application, the Examiner is respectfully requested to call Applicants' attorney at (847) 383-3391.

Respectfully submitted,

Dated: June 24, 2003

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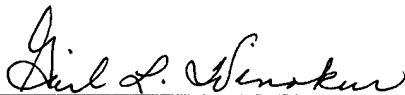
  
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Example 90

2-(Phenylmethyl)-8-[2-[1-[[4-(N,N-diethylaminomethyl)phenyl]methyl]-4-piperidinyl]ethoxy]-2,3,4,5-tetrahydro-1H-2-benzazepine trihydrochloride

